

## **REMARKS**

Applicants have carefully reviewed the Office Action mailed on March 3, 2010. Applicants respectfully traverse all objections, rejections and assertions made by the Examiner. Claims 20-29 are pending.

### **Claim Rejections under 35 U.S.C. § 103**

Claims 20-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Puno (US 5,360,431) in view of Mathews (US 6,033,406) and Foley (US 5,792,044) and Davison (US 2001/0011170). This rejection is respectfully traversed. Puno teaches, “[i]n order to achieve these advantages, the present design utilizes two implant sets on either side of the spinous processes. Each implant set includes a 0.25 inch diameter stainless steel (316L) rod which spans the vertebrae to be immobilized.” See column 3, lines 54-56 and FIGS. 17-19. Puno also teaches, “[a]s a further part of this invention, a cross-link 110 may be used to stabilize the rod members 18 against torsional rotation.” See column 6, lines 27-29 and FIG. 20. Puno appears to teach an open surgical procedure for performing the two-level spinal fixation:

Initially, the area of implantation is surgically approached. A longitudinal posterior midline incision is made over the spine. The incision is carried through the subcutaneous tissue and the fascia to the tips of the spinous processes. Subperiosteal dissection is performed over the laminae and transverse processes. The facet capsule and articular cartilage are removed in preparation for fusion.

See column 6, lines 50-57. The Examiner acknowledges that Puno fails to teach inserting an access device and performing their surgical procedures through an access device. Davison is asserted as teaching a method involving inserting an access device, actuating the access device to a second configuration having an enlarged cross-sectional area at the distal portion spanning at least a portion of the multiple vertebrae, and performing various surgical procedures, such as decompression and fixation procedures, through the access device. The Examiner appears to assert that it would have been obvious to one of ordinary skill in the art to perform the surgical procedure of Puno through the access device of Davison. Applicants respectfully disagree. As discussed above, Puno appear to teach an open surgical procedure for inserting 6 pedicle screws, 2 rods, and one or more cross-linking members, as shown in FIGS. 14-20. Davison teaches, “present invention is applicable to a variety of surgical procedures in which endoscopic surgical

techniques are used.” See paragraph [0017]. Davison also teaches, “[s]urgical instruments are inserted into the body during endoscopic surgery through the passage 16.” See paragraph [0018]. Davison also teaches:

The expandable second tubular portion 40 of the cannula 10 provides a significantly larger working area for the surgeon inside the body 130 within the confines of the cannula. As a result, the simultaneous use of a number of endoscopic surgical instruments, including but not limited to steerable instruments, shavers, dissectors, scissors, forceps, retractors, dilators, and video cameras, is made possible by the expandable cannula 10.

See paragraph [0035]. Applicants submit that one of ordinary skill in the art, upon reading Puno and Davison, would have no rational reason for attempting to perform the multi-level spinal fixation of Puno through the device of Davison. Puno does not teach their surgical procedure as being endoscopic, thus the skilled person would have no rational reason to look to Davison for alternative devices to using an endoscope. The Examiner appears to be asserting that Davison teaches performing decompression and fixation procedures using their device, but the Examiner has not provided any indication of where in the reference this teaching is found. MPEP 2143.01 III states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless \*\*>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007)

Emphasis original. Applicants submit that attempting to performing the complex, open surgical procedure of Puno through the device of Davison would not have given predictable results. As discussed above, Davison appears to teach, “[s]urgical instruments are inserted into the body during endoscopic surgery through the passage 156.” See paragraph [0036]. In view of the teachings of Davison, Applicants submit that the only reason or motivation for one of ordinary skill in the art to attempt to perform the procedures of Puno through the device of Davison is found in Applicants’ specification, which is an error. The Examiner appears to be relying on Applicants’ disclosure and hindsight rather than the actual teachings of the references, in order to make a determination of obviousness. Applicants submit there is nothing in Puno to suggest or lead one of ordinary skill in the art to attempt to perform their open procedure of inserting multiple screws, rods, and cross-linking members through a device described as allowing

passage of endoscopic instruments. Neither Matthews nor Foley appear to provide any rational reason or motivation for modifying Puno as asserted by the Examiner. Reconsideration and withdrawal of the rejection are respectfully requested.

#### **Conclusion**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 767-4574.

Respectfully submitted,

Alan Shluzas et al.

By their Attorney,

Date: 6/1/10



Nancy J. Parsons, Reg. No. 40,364  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349  
email: Nancy.Parsons@cstlaw.com